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10/076,211	02/12/2002	Paul Trpkovski	44046.103.203.21.2	9015

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INTELLECTUAL PROPERTY GROUP  
FREDRIKSON & BYRON, P.A.  
4000 PILLSBURY CENTER  
200 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402

EXAMINER

A, PHI DIEU TRAN

ART UNIT PAPER NUMBER

3637

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/076,211

**Applicant(s)**

TRPKOVSKI, PAUL

**Examiner**

Phi D A

**Art Unit**

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6,8-12,48-51 and 53-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,8-12,48-51,53-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***With respect to the limitation of “glazing compound” in claims 1, 4, 6, 8-12, the limitation is not claimed and is thus treated accordingly as a subcombination with the other claimed structures.***

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

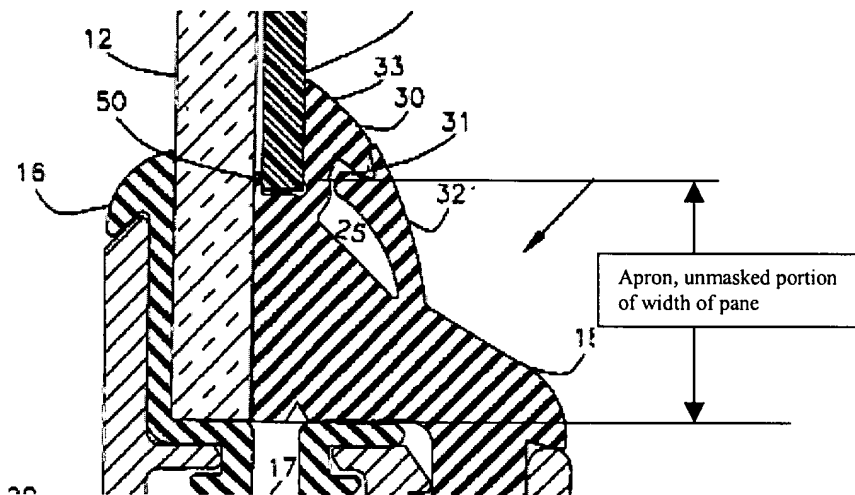
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 48-51, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (5735089) in view of Berg (2874423).

Smith et al (figure 2) shows a glazing assembly comprising a transparent pane (12) and a frame (16, 15) to which the pane is mounted, the frame receives an edge of the pane, the pane having first and second generally opposed major surfaces, the pane having a protective covering (14) disposed over a portion of the first surface, the first surface having an unmasked apron (part not cover by the covering) extending between an outer periphery of the covering and an outer periphery of the pane, the covering having at least one piece of masking material, the masking material being a masking film (the panel 14 is disclosed as being transparent and the claim is not specific to the structure of the film which differentiates the film from the panel ), the masking material is sized, shaped and positioned such that at least one peripheral side portion of the covering extends beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound (there is not compound to engage), the pane is

Art Unit: 3637

mounted such that all edges of the pane are received in the frame, the protective covering sized, shaped, and positioned such that all peripheral side portions of the covering extend beneath confronting surfaces of the frame, the peripheral side portions extend a predetermined distance beneath the confronting surfaces of the frame, the covering consists of a single sheet of masking material.



distance by which confronting surfaces of the frame extend over the first surface when the pane is mounted, such that all peripheral edges of the covering being concealed beneath the frame, the edges of the covering being concealed beneath the frame but do not engage the glazing compound between the frame and the pane (the apron of the pane which contacts the frame on the inside of 11).

Smith et al does not show a glazing compound between the frame and the pane.

Berg discloses a glazing compound (col 2 line 34-37) between the surfaces of the frame and the pane to secure the pane and the frame together.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith et al to show a glazing compound between the frame and the pane because it would further secure the pane and the frame together as taught by Berg.

Smith et al as modified still does not show the covering engaging the glazing compound.

3. Claims 1, 4, 6, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Eckart Jr. (3837949).

Adams Jr. et al shows a transparent window pane (18) having first and second generally opposed major surfaces (20, 21) being sized and shaped to be mounted in a frame configured to received at least one edge of the pane (figures 5b, 6b), the pane having a removable protective covering (22) disposed over all of the first surface except for an unmasked peripheral apron, the masking material being a transparent film (col 3 line 45), the unmasked apron extends between an outer periphery of the protective covering and an outer periphery of the pane.

Adams Jr. et al does not show the protective covering having a plurality of strips of masking material, the strips of masking material being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip, the strips extending substantially in parallel across the first surface of the pane, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesive.

Eckart Jr. discloses a protective covering having a plurality of strips of masking material, the strips being disposed in a sequentially overlapping fashion to cover a large surface area, the strips being affixed to one another by adhesive, the strips extending substantially parallel across the first surface of the pane, the strips defining a plurality of exposed lateral edges.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the protective covering having a plurality of strips of masking material, the strips of masking material being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip, the strips extending substantially in parallel across the first surface of the pane, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesive because it would result in the easy covering of the glass pane for a paint job and removal of the masked material from the window pane when the paint job is done as taught by Eckart Jr.

4. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Eckart Jr. (3837949) as applied to claimed 1 above and further in view of Smith et al (5735089).

Adams Jr. et al as modified shows all the claimed limitations except for the covering being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage glazing compound between the frame and the pane.

Smith et al discloses covering (14) being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage any glazing compound between the frame and the pane, the edges being hidden in grooves.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the covering being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage glazing compound between the frame and the pane as taught by Smith et al because it would enable Adam Jr. et al's modified cover to hide the edges in the groove and thus reducing the precise manufacturing tolerance required of the cover, which would result in cost saving and guarantee covering of the exposed central portion of the pane.

5. Claims 48-51, 53, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089) and Emmanuel (5836119).

Adam Jr. et al shows a glazing assembly having a transparent pane (18) and a frame (26) to which the pane is mounted, the frame receives an edge of the pane, the pane having first and second generally opposed major surfaces (20b, 21b), at least one edge received in the frame, the pane having a protective covering (22b) disposed over a portion of the first surface, the first surface having an unmasked apron (the surface not covered) extending between an outer periphery of the covering an outer periphery of the pane, the covering consisting of a single sheet of masking material, the masking material being a masking film (transparent layer), the pane being part of a multiple pane insulating glass unit (col 1 lines 49-51), the pane being mounted such that all edges of the pane being received in the frame (figure 5b, 6b).

Adams Jr. et al does not show at least one piece of masking material having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame,

Art Unit: 3637

the side portions extending a predetermined distance beneath the confronting surfaces of the frame, a glazing compound between the pane and the frame.

Smith et al shows at least one piece of masking material (14) having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame (33), the side portions extending a predetermined distance beneath the confronting surfaces of the frame, the edges of the covering being inside grooves to hide the edges.

Emmanuel shows a glazing compound (83) connecting the frame and pane together.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adam jr. et al to show at least one piece of masking material having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame, the side portions extending a predetermined distance beneath the confronting surfaces of the frame as taught by Smith et al, a glazing compound between the pane and the frame as taught by Emmanuel because having the covering beneath a confronting surface of the frame would enable Adam Jr. et al's cover to hide the edges in groove and thus reducing the precise manufacturing tolerance required of the cover, which would result in cost saving and guarantee covering of the exposed central portion of the pane, and having a glazing compound within the frame would enhance the securement of the frame to the pane as taught by Emmanuel.

6. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089) and Emmanuel (5836119) as applied to claim 48 above and further in view of Tachauer et al.

Adam Jr. et al as modified shows all the claimed limitations except for the covering comprising a plurality of strips of masking material.



Tachauer et al discloses a protective covering having a plurality of strips of masking material (figure 4A) to cover a large surface without resorting to one large (large in both dimensions) piece of covering.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the protective covering having a plurality of strips of masking material because it would allow for the covering of large surfaces without resorting to one large piece of covering as taught by Tachauer et al, and thus resulting in cost saving per easy covering of the pane.

7. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089) in view of Emmanuel (5836119).

Smith et al (figure 2) shows a glazing assembly having an insulating glass unit (12) and a frame (33, 20) to which the insulating glass unit is mounted, the unit having a first pane (12) having generally opposed inner and outer surfaces, the first pane having at least one edge received in the frame, a protective covering (14) is disposed over a portion of the outer surface of the first pane, the outer surface of the first pane having an unmasked apron extending between an outer periphery of the covering and an outer periphery of the first pane, the covering having at least one piece of masking material (14) being sized, shaped and positioned such that at least one peripheral side portion of the covering extending significantly beneath a confronting surface of the frame (33), the masking material being a masking film (the panel 14 is disclosed as being transparent and the claim is not specific to the structure of the film which differentiates the film from the panel), at least one peripheral side portion of the covering extending a predetermined distance beneath a confronting surface of the frame.

Smith et al does not show the unit having a second pane, the second pane having at least one edge received in the frame, glazing compound located between the frame and the outer surface of the first pane but not between the frame and outer surface of the second pane.

Emmanuel (figure 3) shows a window unit having a first and second pane (46, right and left respectively), the second pane having at least one edge received in the frame (96, figure 9), glazing compound (83) located between the frame and the outer surface of the first pane (46 right), a protective covering being disposed over a portion of the outer surface of the first pane, the outer surface of the first pane having an unmasked apron extending between an outer periphery of the covering and an outer periphery of the first pane.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith et al to show the unit having a second pane, the second pane having at least one edge received in the frame, glazing compound located between the frame and the outer surface of the first pane but not between the frame and outer surface of the second pane because having two glass pane in an insulating unit is well-known to enhance the insulation proper of the glass unit, having glazing compound between the frame and the outer surface of the pane would further secure together the pane and the frame as taught by Emmanuel, and having the glazing compound only between the first panel and the frame but not the second pane and the frame would have been an obvious matter of engineering design choice as it is a choice by the designer whether to further secure the second pane to frame with a glazing compound.

Art Unit: 3637

8. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089) in view of Emmanuel (5836119) as applied to claim 56 above and further in view of Kupec et al (2672122).

Smith et al as modified shows all the claimed limitations except for the covering having at least one tab or extension to facilitate removing the covering.

Kupec et al shows a tab (36) attached to the covering to facilitate removing of the covering.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith et al's modified structure to show the covering having at least one tab or extension to facilitate removing the covering because it would facilitate easy removal of the covering as taught by Kupec et al.

Per claims 59-60, Smith et al as modified by Emmanuel and Kupec et al shows all the claimed limitations except for the distance being at least 1/16 inch and about 1/8 inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith et al's modified structure to show the distance being at least 1/16 inch and about 1/8 inch because it would have been an obvious matter of design choice to show the distance being at least 1/16 inch and about 1/8 inch since such a modification would have involved a mere change in the size of a component/groove. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 4, 6, 8-12, 48-51, 53-55 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 11/17/03 to claims 56-60 have been fully considered but they are not persuasive.

Applicant states that Smith does not show a film as Smith's panel would sag if it were a film, examiner respectfully disagrees. Smith discloses a panel which is transparent. The panel functions the same as applicant's film to cover a glass pane. There is nothing in applicant's claim which differentiate applicant's film from that of Smith's. If applicant insists that the difference being that applicant's film cannot stand up by itself, perhaps applicant should put the limitation into the claim language to clearly distinguish the invention from that of Smith. The argument is thus moot.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different panel covering systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large, stylized loop at the end.

Phi Dieu Tran A

2/23/04